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In the Supreme Court of the United States

OCTOBER TERM, 1965

No. [redacted] 737

THE V. L. SMITHERS MANUFACTURING COMPANY,
Petitioner,

vs.

WILLIAM P. O'BRIEN and
WILLIAM J. O'MALLEY, d.b.a.
ILLINOIS WHOLESALE FLORIST,
Respondents.

PETITION FOR WRIT OF CERTIORARI
To the United States Court of Appeals
For the Seventh Circuit.

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ILLINOIS WHOLESALE FLORIST,

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PETITION FOR WRIT OF CERTIORARI
To the United States Court of Appeals For the Seventh Circuit.

Petitioner, The V. L. Smithers Manufacturing Company, prays that a Writ of Certiorari issue to review the Judgment of the United States Court of Appeals for the Seventh Circuit, entered in the above-entitled case on December 23, 1964.

OPINIONS BELOW.

The opinion of the United States District Court for the Southern District of Illinois, Northern Division is reported at 227 F. S. 472 and 141 U. S. P. Q. 127. The opinion of the Court of Appeals is reported at 340 F. 2d 952 and 144 U. S. P. Q. 117. Both opinions are printed in the Appendix at pages A1 to A13.

JURISDICTION.

The judgment of the Court of Appeals was entered December 23, 1964. A Petition for Rehearing, filed January 7, 1965, was denied on February 16, 1965. The jurisdiction of this Court is invoked under 28 U. S. C. 1254(1).

QUESTIONS PRESENTED.

1. Does the cancellation of a rejected claim constitute a disclaimer, not only of the cancelled claim, but also of equivalents of a granted claim which are not equivalents of the cancelled claim, when the cancelled claim lacked an element essential to the utility of the invention and the granted claim included that element?

2. Can the rejection and cancellation of a claim not including an essential element defeat the statutory mandate (35 U. S. C. 112) that a claim to a combination which includes that element defined by its function, "shall be construed to cover," not only the corresponding structure described in the specification, but also "equivalents thereof"?

3. Should the ruling of this Court in *Sinclair Co. v. Interchemical Corp.*, 325 U. S. 327, 330, that after trial of a patent infringement action it "will usually be the better practice" to decide validity, be modified and strengthened to require a decision on both validity and infringement in the absence of compelling reasons to the contrary?

STATUTE INVOLVED.

The statutory provision involved is the last paragraph of Section 1, Patent Act of July 19, 1952, C. 950 § 1, 66 Stat. 798; 35 U. S. C. 112:

> "An element in a claim for a combination may be expressed as a means or step for performing a speci-

fied function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

STATEMENT OF THE CASE.

In this action for infringement of petitioner's Patent No. 2,753,277 (107a)* respondents, by Answer and by Counterclaim, asserted invalidity and non-infringement (1a). After trial of both issues the District Court found non-infringement by reason of estoppel and entered judgment dismissing the Complaint without ruling on validity (A10). The Court of Appeals of the Seventh Circuit affirmed on the opinion of the District Court (A12-A13).

The patented subject-matter is a water retentive foam for supporting cut flowers and supplying them with water. It is used by florists as a base for decorative and artistic flower arrangements. The particular foam itself is hydrophobic—that is, it resists being wetted by water and will absorb only small quantities of water after long periods of immersion.

The patent discloses the inventor's discovery that a concentrated solution of a wetting agent sprayed onto an exterior surface of the foam soaks in a short distance and dries as a thin layer at the surface (109a, col. 3, ll. 67-69). The evaporation of the water in drying concentrates the dissolved material at the surface (34a, 99a) leaving a lesser amount in the cells of the foam (99a). This concentrated surface layer, positioned to contact the water when the treated foam is immersed in water, carries the

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* Pages of petitioner's Appendix filed in the Court below are referred to as (a); pages of the Appendix annexed to this Petition are referred to as (A).

water into the interior of the foam, completely saturating it.

The inventor first filed an application for patent which was incomplete and which was later abandoned and replaced by the application which resulted in the patent in suit. The estoppel found by the Court below is based on claim No. 1 rejected and cancelled in the first application (130a):

> "1. As an article of manufacture, a synthetic organic foam and a wetting agent carried in the cells thereof."

This claim included as an element only that portion of wetting agent "in the cells" of the foam; it did not include the "exterior layer" element of the patented claims.

This claim was rejected and cancelled, the inventor acknowledging that the element of wetting agent "in the cells" was old, and pointing out that it did not work and did not achieve the new results of his invention (136a).

The patented claims 1 to 5 (110a) do not include in the claimed combination any wetting agent "carried in the cells"; instead, they include as an element a "layer" or a "dried layer" of "a wetting agent on the exterior of the mass" of foam. The position and quantity of the "layer" are defined by the functional expression "adapted to carry water into the interior of the mass."

The Accused Material.

The accused material consists of bricks of the same foam used by petitioner pierced by a large number of passages opening to the outside through one face. A solution of wetting agent in water is applied to the surfaces of the foam surrounding the passages and allowed to dry. The material is shown and described in the Palombo patent No. 3,049,444 (5a).

The passages, indicated at 44 in the Palombo drawing (5a), are of a size to permit water to flow rapidly through them into contact with the exposed layers of wetting agent on the surfaces of the foam surrounding the passages. The Palombo patent says (Col. 3, ll. 1-3, 8a):

> "The presence of these passages 44 permits the rapid entry of water when the mass is submerged therein."

As the District Court found, the water enters the passages and contacts the wetting agent (146a):

> "* * * after which water is quickly drawn into the interior of the mass of foam."

The Ruling of Estoppel.

Conflict with the decisions in other circuits arises from the ruling by the Courts in the instant case that petitioner is estopped to cover an equivalent of the granted claims which is not the same as, or equivalent of, the cancelled claim. The District Court said:

> "The accused product does accomplish the same result as plaintiff's patented product by the use of the same combination of elements" (144a).
>
> * * * * *
>
> "I hold that the surfaces of the perforations within the body of the accused product are not a part 'of the exterior of the mass' within the meaning of the claims of the patent in suit.
>
> "Plaintiff is estopped to rely upon the doctrine of equivalents to prove infringement." (148a.)

After quoting the cancelled claim 1, which included the element of wetting agent "in the cells" but did not include the dried exterior layer element of the patented claims, the Court continued:

"Having so limited his claims to overcome the rejection of this application, plaintiff is estopped to claim a monopoly upon the use of wetting agent *within the mass* by invoking the doctrine of equivalents." (148a; emphasis ours.)

The relocation of the dried exterior layer onto the exposed surfaces of the passages recessed into the outline of the mass is not the same as, or the equivalent of, the wetting agent "in the cells" which was disclaimed.

REASONS FOR GRANTING THE WRIT.

1. The Conflict With Other Circuits.

The extension of the rule of estoppel by the Courts below—depriving Petitioner of protection against the flimsiest and most transparent subterfuge designed to shelter the piracy of the patented invention—is in direct conflict with decisions of Courts of Appeals for the Second, Fifth, Sixth and Eighth Circuits, and is an important question of patent law that has not been decided by this Court.

This Court's decisions have held that a patentee is estopped to claim the benefit of a rejected claim, or such a construction of his granted claim as would be equivalent thereto (*Morgan Envelope Co. v. Albany Paper Co.*, 152 U. S. 425, 429; *I. T. S. Rubber Co. v. Essex Rubber Co.*, 272 U. S. 429, 444; *Exhibit Supply Co. v. Ace*, 315 U. S. 126, 136). This rule is not in dispute and is not involved here.

But we find no decision of this Court holding the converse; that the estoppel does not preclude such a construction of the granted claim as is not the same as, or in any way equivalent to, the rejected claim; or holding, in the words of the Court of Appeals for the Eighth Circuit: "that

is the limit of the estoppel." (*New York Scaffolding Co. v. Whitney,* 224 Fed. 452, 462, C. A. 8.)

This question of the proper limits of the estoppel rule is of importance to the entire field of patent law and is of extreme importance to the individual or "garret" inventors (such as Petitioner's assignor) who file applications disclosing only the best form of their invention, relying on the law to protect them against equivalent modifications or improvements,* as distinguished from corporate research groups with the money to explore and disclose all equivalent variations.

The Petitioner's invention filled the "two basic needs" (A1) for optimum results in floral arrangement, and the rapid growth in sales of the new product (112a) created a new industry. Respondents' supplier, which is defending this action, first duplicated Petitioner's commercial product and after notice of infringement (119a) substituted the accused material which it patented as an improvement over Petitioner's patent in suit (7a). It is claimed to be an improvement because it saturates more rapidly; this follows from the increase in exterior surface area provided by the passages for water extending into the block with their dried surface layers of wetting agent. It is now settled that improvement does not avoid infringement. (*Temco v. Apco,* 275 U. S. 319, 328.)

Since the beginning of our patent system successful inventions have been beset by attempted piracy with all the stratagems man's ingenuity can devise. In *Goodyear v. Day,* Fed Cas. 5569, 10 Fed. Cas. 678, 684 (1852), Mr. Justice Grier, sitting in the Circuit Court, said:

> "Every one who can invent an improvement, or vary its form, claims a right to pirate the original discovery.

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* *U. S. vs. Anciens Etablissements Cail,* 224 U. S. 309, 328.

> We need not summon Morse, or Blanchard, or Woodworth to prove that this is the usual history of every great discovery or invention."

Since this Court's reaffirmance of the doctrine of equivalents in *Graver Mfg. Co. v. Linde,* 339 U. S. 605, there have been increasing efforts to expand the estoppel rule so as to bar the application of the doctrine, culminating in the decisions of the Courts below in the instant case denying coverage of the most palpable equivalent of the new element in the claims because of the prior cancellation of a claim lacking that element and containing, instead, a different element which was both old and inoperative.

The decisions in other Circuits conflicting with the decision below arose on varying facts, but each limits the application of the estoppel rule consistently with the general principle that cancellation of a claim does not preclude such a construction of a granted claim as is not the same as, or in any way equivalent to, the rejected claim.

In *Southern Textile Machinery Co. v. United Hosiery Mills Corp.,* 33 F. 2d 862, the Court of Appeals for the Sixth Circuit said, page 866:

> "This doctrine does not, however, go to the extent of depriving a patentee of protection against all equivalents * * *."
>
> * * * * *
>
> "* * * the estoppel should go no further than to bar the patentee from reliance upon the canceled claim in its broadest or generic construction."

In *Farrington v. Haywood,* 35 F. 2d 628 (C. A. 6), the Court said, pages 630-631:

> "But we are of the opinion that, if the language adopted permits, 'he is not estopped from claiming and securing by the amended claim every improvement and

combination which he has invented and which was not disclosed by those references.' "

In *Musher Foundation v. Alba Trading Co.*, 150 F. 2d 885, C. A. 2, the Court, speaking through Judge Learned Hand, said, page 888:

> "The applicant may not by resort to the doctrine of equivalents interpret any claim which he succeeds in getting allowed, so that it will cover the contents of the rejected claim without some limitation."
>
> * * * * *
>
> "That surrender does not of course result in a dedication of all species of the genus surrendered; but it does surrender any monopoly upon the genus as such: i.e. unless it be restricted to some species of that genus."

In each of those cases in the Sixth and Second Circuits the granted claims were limited to a species of the broad genus of the cancelled claim, but there was no estoppel to cover equivalent variations of that species.

In the instant case, on the contrary, the interpretation of the claims to cover the accused material, which was refused by the Court below, would not in any way cover the contents of the rejected claim since it would not be claiming the wetting agent "in the cells." In addition, the patented claims remain definitely limited to the exterior layer even when interpreted to cover the relocation of that layer on the surfaces of the holes recessed into the accused foam.

In *Hunt Tool Co. v. Lawrence*, 242 F. 2d 347, C. A. 5, the Court said, page 354:

> "Also, since the patent examiner's objection was with reference to the prior art, appellants are protected by file wrapper estoppel only if they can show that their alleged infringement is in an area to which the

prior art could possibly have been thought to extend so as to make it impossible to make valid claims there, for there is no reason to presume that applicant made a disclaimer broader than necessary to yield to the actual challenge to his claim."

In *New York Scaffolding Co. v. Whitney,* 224 Fed. 452, the Court of Appeals for the Eighth Circuit said, page 462:

"While a patentee who acquiesces in the rejection of his claim, and abandons it on references cited in the Patent Office, and accepts a patent on an amended claim, is thereby estopped from maintaining that the latter claim covers the combination shown in the references, and that it has the breadth of the abandoned claim that was rejected, *that is the limit of the estoppel.*

* * * * *

"* * * one who acquiesces in the rejection of his claim because it is said to be anticipated by other patents or references *is not thereby estopped from claiming and securing by an amended claim every novel and useful improvement that is not described in those references."* (Emphasis ours.)

In these cases in the Fifth and Eighth Circuits the estoppel from cancellation of claims rejected on prior art was limited to the prior art and its equivalents; the Courts did not permit the appropriation of the patented invention by mere literal departure from the claims while retaining the same essential distinction from the prior art.

In the instant case the granted claims distinguish from the cancelled claim and the prior art on which it was rejected by including the exposed layer of wetting agent on the exterior of the foam to carry water into the interior. The accused material retains this same exposed exterior layer and the same distinction from the cancelled claim and the prior art, differing from the patentee's preferred

form only in repositioning the exterior layer onto holes recessed into the block. The extension of the estoppel rule by the Courts below in the instant case to bar resort to the doctrine of equivalents is in direct conflict with the ruling by the Courts of other Circuits in each of the cited cases.

A resolution of this conflict by this Court is clearly of great importance to the patent law. Cancellation and amendment of claims is the usual course in the prosecution of patent applications. It is equally important to the public, the beneficiary of the disclosures inventors are induced to make by the reward promised in a patent grant. To bar arbitrarily all resort to the doctrine of equivalents because of the cancellation of a claim to a different combination, in no way equivalent to the alleged infringement, would have the same adverse effect on the public interest as repealing the doctrine itself. As this Court said in *Graver Mfg. Co. v. Linde,* 339 U. S. 605, 607:

> "Outright and forthright duplication is a dull and very rare type of infringement. To prohibit no other would place the inventor at the mercy of verbalism and would be subordinating substance to form. It would deprive him of the benefit of his invention and would foster concealment rather than disclosure of inventions, which is one of the primary purposes of the patent system."

2. The Conflict With the Statute.

The decision of the Courts below denying to Petitioner's claims a construction covering equivalents is also in direct conflict with the provision in the Patent Act of 1952 which appears as the final paragraph of 35 U. S. C. 112 (*supra,* pp. 2-3). This statute provides that an element in a combination claim may be expressed as "a means" for performing a particular function without re-

citing all of the structure or material necessary to obtain the function, and provides that such a claim "shall be construed" to cover the corresponding structure described in the specification "and equivalents thereof."

The claims in suit recite a "layer" or a "dried layer" of a "wetting agent" on the "exterior of the mass" of foam, which is "a means," and further define the exposed position and quantity of this "means" by the functional expression "adapted to carry water into the interior of the mass." This function requires that the layer be positioned to contact water when the mass of foam is immersed in water, and that it be sufficient in quantity and concentration to carry water into the interior.

The statute contains no exception to this mandatory provision that the claim "shall be" construed to cover equivalents. It applies to construction of the claims in determining validity as well as in determining infringement, and in neither case does the statute authorize or permit a more limited construction because of a prior cancellation of some other claim.

It is plain that if a prior art device is, in fact, an equivalent of the corresponding structure described in the specification, performing the function recited in the claim, the statute requires the claim to be construed to cover that prior art device and, therefore, to be invalid. Clearly a patentee would not be heard to urge his claim should be given a narrower construction to save it from invalidity over a prior art equivalent because of the cancellation of other claims in his application. Equally clearly, the statute allows no room for such a narrowing construction at the behest of an infringer.

In other words the statute defines the scope of the language of the claims before consideration of the doctrine of equivalents as to matters falling outside that language,

and therefore before consideration of any estoppel from cancelled claims which might bar application of the doctrine of equivalents.

Neither the doctrine of equivalents nor any question of estoppel arises if the accused matter is within the claim, as this Court said in *Graver Mfg. Co. v. Linde Co.*, 339 U. S. 605, 607:

> "If accused matter falls clearly within the claim, infringement is made out and that is the end of it."

Under the statute the matter that falls clearly within that part of the claim reciting "a means" defined by its function is the corresponding structure described in the patent and equivalents thereof. The decision of the Courts below is directly contrary in holding Petitioner is barred from covering an equivalent relocation of the layer of wetting agent where it continues to perform the claimed function of carrying water into the interior of the mass.

A resolution of this conflict between the decision below and the statutory provision is, likewise, a question of substantial importance to the patent law and to the public, and one which has not yet been, but should be, decided by this Court.

3. Should the District Courts Rule on Validity?

This question alone presents no reason for granting the writ in this case. However, if the Court should grant the writ to resolve the conflict on infringement and estoppel, Petitioner respectfully submits the existing directives should be modified and strengthened to require that when both issues of validity and infringement are tried, both should be decided by the District Court, in the absence of compelling reasons to the contrary, in order to reduce piecemeal decisions and appeals. The Courts in the

different Circuits have given different interpretations to the existing directive on this subject.

The Court of Appeals for the Second Circuit in *Harries vs. Air King Prod. Co.*, 183 F. 2d 158, 162-163, analyzed this Court's directive as not being "peremptory," but rather a "cautionary admonition" to be followed when that is the "more convenient course."

The Court of Appeals for the Ninth Circuit in *Coe Mfg. Co. vs. Jeddeloh Bros.*, 306 F. 2d 455, on an appeal from a judgment holding non-infringement without ruling on validity, vacated the judgment and remanded the case to the District Court for a decision on both validity and infringement. In that case, as in the instant case, and in *Altvator v. Freeman*, 319 U. S. 359, 363, validity was put in issue both by the complaint and answer and by a counterclaim for declaratory judgment.

The practice in the Seventh Circuit has been to permit piecemeal disposition without directives to the District Courts to the contrary. Thus, in *Holland Co. v. American Steel Foundries*, 190 F. 2d 37, the Court reversed the District Court's judgment which found non-infringement without deciding validity and remanded the case for further decision. In *Holland v. American Steel Foundries*, 196 F. 2d 749, C. A. 7, the Court affirmed the District Court's decision on remand that the patent was invalid.

It cannot be doubted, as this Court said in *Sinclair Co. vs. Interchemical Corp.*, 325 U. S. 327, 330, that of the two questions validity has the greater public importance. This is true whether the patent is valid or invalid. It would be helpful in economizing judicial time and effort, and in reducing the expense to litigants, if the trial court in every patent case would decide both issues, particularly when both are presented in a counterclaim as well as in the complaint.

CONCLUSION.

For the foregoing reasons this Petition for a Writ of Certiorari should be granted for determination of questions 1 and 2. If granted, question 3 is also presented for decision.

Respectfully submitted,

H. F. McNENNY,

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May 13, 1965.

APPENDIX

APPENDIX.

MEMORANDUM, CONCLUSIONS OF LAW AND JUDGMENT OF THE DISTRICT COURT.

(Entered March 18, 1964.)

Plaintiff, The V. L. Smithers Mfg. Co., is the owner by assignment of the United States Letters Patent No. 2,753,277, issued July 3, 1956, to Vernon L. Smithers relating to the manufacture of an absorbent material for floral arrangements. Plaintiff is engaged in the manufacture and sale of the patented product, namely, a hydrophilic floral foam, which it markets under the trade name "Oasis."

Defendants are wholesale florists, doing business in the State of Illinois. They sell the accused product which is manufactured by American Metaseal of Massachusetts, Inc., and is marketed under the trade names of "Aquafoam" and "Quickee."

Defendants pleaded invalidity of the patent and noninfringement thereof as defenses to the suit. After a trial of the cause, and the submission of briefs by the respective parties, the case is before the court upon the issues joined by defendants' answer.

The patent and the issues are best understood by a brief history of the prior art. Floral arrangement has two basic needs for optimum results. The first is a material which will hold the stems of the cut flowers in place and preserve the arrangement thereof. Secondly, for optimum utility, such material needs to be quickly water absorbent and water retentive. Sponge, moss and a number of other substances were used from time to time for such arrangements, but without completely satisfactory results. Some of the substances known and used by the art did not readily support cut flowers and none had the water retention qualities which were desirable.

Foam material made from urea-formaldehyde and phenolic condensation resin were known to the art long before the Smithers patent.[1] Such foam is very light in weight and contains within a given mass thereof a great number of sealed bubbles, or voids. It is hydrophobic (water repellant) by nature. As the evidence adduced in this case reveals, the U. S. Rubber Company manufactured such a foam under the name "Flotofoam" which was used extensively during World War II to float military equipment in water. Thus, the foam itself lacked one of the necessary qualities for use in the arrangement of cut flowers, namely, it was not readily saturable. On the other hand, such foam is frangible by nature, even when saturation is achieved, and will readily admit the stems of cut flowers to be forced into the mass thereof without breaking the foam and will readily support even heavy cut flowers.

One of the first uses of urea-formaldehyde foams for flower arrangements was the "Sno-Pak" product manufactured and marketed by U. S. Rubber Company, among others. Saturation of the Sno-Pak product was achieved by placing the mass of the foam under water where it was crushed by a lever-plate mechanism, thus opening the walls of some of the closed voids in the foam and admitting water thereto.

That, in brief summary, is the state of the art prior to the Smithers' patent.

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[1] Phenolic resin foams are a generic group of related compounds having as base components urea-formaldehyde and a phenolic condensation resin. For purposes of this opinion, the foam used by plaintiff and that used in the accused product are treated as identical materials, ignoring possible variations in the precise basic composition thereof.

The Patent in Suit.

Basically, what Mr. Smithers did was to combine urea-formaldehyde foam with a wetting agent[2] to make the foam readily saturable (hydrophilic) with the result that a given mass of the foam, treated in the manner taught by the patent, would readily absorb and retain many times its weight in water. When thus saturated, stems of cut flowers can be inserted into the saturated mass of foam without distortion of the mass so that they remain supported in place for the life of an arrangement and there is no drainage or loss of water from the mass of foam.

Claim 1 of the patent in suit is illustrative of the three claims alleged to be infringed. It claims: "As a new article of manufacture a water retentive mass of a foamed synthetic material selected from the group consisting of urea-formaldehyde and a phenolic condensation resin, suitable for supporting the stems of cut flowers, said mass being frangible when saturated with water so as to allow penetration of the stems of flowers without distortion of the

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[2] "Wetting Agent" is a generic term, descriptive of a large number of chemical substances which have the property of causing water to penetrate water repellant materials. Because the molecules of water strongly attract each other, its surface tension is extremely high. When water is placed on a water repellant material which it has the incapacity to wet readily, this attraction of the molecules for each other causes a drop of water to assume a spherical shape as the outermost molecules are drawn inwardly toward the molecules in the center of the drop. Wetting agents have a two-part molecule. One part is attracted to water, while the other part is repelled by water. When such an agent is placed in water, the molecules of the agent tend to concentrate on the surface of the water with the repelled part at the surface. This film of hydrophobic molecules at the surface interferes with the cohesive attraction of the water molecules for each other, greatly diminishing the surface tension. Since the hydrophobic part of the agent is itself attracted to hydrophobic materials, when water containing a wetting agent is placed on a water-repellant substance, the attraction of the wetting agent to the molecules of the substance causes the water to flow into and wet the substance.

mass and having a mutiplicity of small bubble-like voids, and a layer of a wetting agent on the exterior of the mass adapted to carry water into the interior of the mass."

Claim 2 is identical to Claim 1 except that it claims, in the last clause thereof, "A dried layer of a liquid wetting agent on the exterior of the mass adapted to carry water into the interior of the mass." Claim 3 is likewise identical to Claim 1 except that it claims in the last clause thereof, "A dried layer of a liquid wetting agent on the exterior of the mass adapted to carry water into the interior of the mass and into any closed voids." [3]

The product, Oasis, manufactured under the Smithers patent, is manufactured by foaming large quantities of material which, when set and dried, produce large blocks of the foam material. These are then cut into brick shaped blocks of the desired size, upon all exterior surfaces of which a wetting agent is applied and permitted to dry. The blocks are then sold to the floral industry in such prepared state. As needed, the florist simply places the block in a container of water wherein it becomes saturated in a brief period of time.[4]

The Accused Material.

"Aquafoam" or "Quickee," is also manufactured by combining urea-formaldehyde foam with a wetting agent to achieve the same result as plaintiff's Oasis.

The accused product is made from a phenolic resin foam of the same character as that used in Oasis. After the foam has set and dried, it is cut in blocks or masses of the

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[3] Claims 4 and 5 of the patent are dependent claims, defining the limits of acidity of foams manufactured as described in claims 1 to 3.

[4] A second embodiment of the claimed invention is the use of the foam material in shredded form.

desired size. These blocks or masses are placed upon a machine which injects one surface of the block with a large number of needles which penetrate the mass to within a short distance from the opposite surface thereof. After the points of the needles have penetrated within the interior of the mass, a liquid wetting agent is fed through the needles into the mass. The machine used is so designed that the feed of wetting agent through the needles ceases before the needles are withdrawn from the block of foam. The resulting product is a mass of foam having a large number of holes or openings upon one exterior face thereof with the wetting agent disposed therein.

When used, the mass of foam is placed in water with the holes down. The result is a product which is readily saturable with water and which tends to reach saturation more quickly than does Oasis.[5]

Infringement.

Upon the issue of infringement, it is axiomatic that the monopoly of a patent is limited by the claims thereof.

The elements comprising the claims of this patent, namely, urea-formaldehyde, phenolic resin foam and the employment of wetting agents to achieve wetting are both old in the art and, thus, not the subject of monopoly. Thus, using claim 1 as an example, the critical language is the last clause describing the particular combination of such known elements to achieve novelty, to-wit, a combination of a foam of the type thereinbefore described with "a layer of a wetting agent on the exterior of the mass adapted to carry water into the interior of the mass."

The accused product does accomplish the same re-

[5] The accused product is manufactured by a process described in U. S. Letters Patent No. 3,049,444, issued August 14, 1962, to Albert M. Palombo, the President of American Metaseal.

sult as plaintiff's patented product by the use of the same combination of elements. In view of the limitation upon the patent claims to a combination having a layer of wetting agent upon the exterior of the mass sufficient to carry water into the interior of the mass, the issue upon infringement is the question whether the accused product has a like layer of wetting agent on the exterior of the mass.

Each party called expert witnesses who reached diametrically opposed conclusions upon the question whether active wetting agent was present on the exterior of the accused product.[6]

Mr. Wetherill, for plaintiff, concluded that there was wetting agent upon the exterior of the accused product from mechanical tests which he had performed.

Dr. Colburn, for the defendant, conducted chemical analyses of the accused product and certain mechanical tests which led to his conclusion that there was no wetting agent, or only an insignificant trace of active wetting agent, upon any of the external surfaces of the accused Aquafoam. He found the wetting agent contained in the product concentrated in the interior of the mass.

A series of mechanical tests performed by Dr. Colburn are enlightening. A block of the accused foam placed in water with the holes down became completely saturated within one hour. By way of contrast, blocks floated upon water with the holes up failed to absorb water and remained floating at the end of twenty-four hours. He removed a slice one-half inch thick from the perforated side of an Aquafoam block, thus exposing a surface having

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[6] A small quantity of a wetting agent is an ingredient of the foam itself. Although that wetting agent remains within the cells of the mass of foam, it does not remain as an active wetting agent because of a reaction to the foaming process. Thus, the exterior of the blank foam contains chemically detectable traces of residue of the agent used in the foaming process.

substantial wetting agent upon it, which he covered with an untreated piece of foam, with the joint sealed to prevent the entry of water therethrough. He placed that composite in water, with the grafted untreated surface down. The block continued to float at the end of twenty-four hours with no significant penetration of water thereinto. To one perforated blank block of foam, Dr. Colburn joined a slice ¼ inch thick from the perforated side of a block of commercial Aquafoam. To another, he joined a ⅛ inch thick slice from the perforated side of a treated Aquafoam block. When these are floated upon water, saturation of only the treated section was achieved. No significant penetration of the untreated foam was noted. To an unperforated, untreated block of foam, Dr. Colburn affixed a ⅛ inch thick slice from the exterior of an Oasis block, with the exterior of the Oasis block becoming one exterior surface of the composite. When placed upon water, with the Oasis side down, approximately one-half of the composite block became saturated and submerged within thirty minutes. As a final test, Dr. Colburn cut a ¼ inch slice from the perforated face of a commercial Aquafoam block. To that surface, he attached a ¼ inch slice from an untreated block which had been perforated with the same hole pattern as the commercial Aquafoam. The composite so formed, when placed in water with the holes down, became saturated and sank within thirty minutes.

I find the Colburn tests extremely significant. They lead to the conclusion that there is no significant amount of active wetting agent upon any of the exterior dimensions of the accused foam. Rather, the accused device depends for its success upon water entering through the many perforations to contact the wetting agent within the mass, after which water is quickly drawn into the interior of the mass of foam.

In fact, Dr. Colburn's conclusions are not seriously contradicted by the testimony of Mr. Wetherill. The latter testified that an analysis of the surface of the accused product was inconclusive with respect to the question whether active wetting agent was, or was not, present. He did testify that he floated a block of the accused foam upon water with the holes up and that that block became saturated and sank. There is, however, no dispute in the evidence that foams vary from batch to batch and that some open cells are formed. In weighing all of the evidence, it is illogical to assume that active wetting agent must have been present on the outer surface of the latter block to account for its saturation. As Mr. Wetherill admitted, if there were an opening in the exterior of the mass which would admit water into the interior of the mass and into contact with the wetting agent therein, the mass would then wet rapidly.[7]

I find from all of the evidence that there is no significant amount of wetting agent upon any exterior surface of the accused product. It is certain that there is absent a "layer" of wetting agent, and no amount of wetting agent on any exterior face of the material adequate "to carry water into the interior of the mass."

Indeed, plaintiff virtually concedes that finding by its assertion that the circumference of each of the holes in the accused product is a part of the exterior of the mass. It argues that the wetting agent within the mass of the accused product would be principally concentrated upon the surfaces within the many holes, and that perforation of the mass merely increases the exterior surface thereof.

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[7] Wetherill's report of his float test indicates that the block tilted to one side before it became saturated and sank, indicative of the fact that wetting began in one area of the block, as distinguished from uniform wetting over the whole of a treated surface.

I reject the argument. The claims speak of "exterior" and it is clear from the teaching of the patent that that term was used in its ordinary sense, i.e., as descriptive of the outer faces of the mass. One cannot read the specifications without concluding that the inventor attached no special or unusual meaning to that word. The specifications state, inter alia: "It has been discovered that if the foam, after being produced in the manner described, is given an exterior coating of a wetting agent, the absorptive properties of the foam are increased to a degree which is astonishing.

"For this purpose a block of foam * * * is sprayed with a wetting agent so that the agent dries in a thin layer at the surface of the block. The layer of wetting agent does not penetrate appreciably into the block but remains as a solid coating over the exterior of the block until the block is immersed in water." Continuing, its states:

"The fact that the wetting agent is concentrated on the surface of the block and is carried into the block by the water, causes the concentration of the wetting agent to progressively diminish as the water is absorbed by the block. This action is very desirable because the concentrated wetting agent is not beneficial to the flowers, but as it is only in a very dilute solution in the interior of the block, any deleterious effects of the wetting agent are nullified.

"An important advantage in coating the exterior of the foam with the wetting agent is that the dried layer of wetting agent will act as a binder over the exposed surfaces of the block, and this will prevent the objectionable dusting off of fine particles of the material in handling."

I hold that the surfaces of the perforations within the

body of the accused product are not a part "of the exterior of the mass" within the meaning of the claims of the patent in suit.

Plaintiff is estopped to rely upon the doctrine of equivalents to prove infringement. The original Smithers application contained a claim as follows:

"As an article of manufacture, a synthetic organic foam and a wetting agent carried in the cells thereof." The application was rejected by the Examiner on the prior art and, also, because the claim was broad enough to cover synthetic rubber and all other plastic foams."

In response to that rejection, the specifications were amended to teach the application of the wetting agent to the exterior of the foam. The original claims were cancelled and new claims were drawn to include a specification of the group of foams included within the teaching of the patent, in combination with a layer of wetting agent applied to the exterior of the mass. Having so limited his claims to overcome the rejection of this application, plaintiff is estopped to claim a monopoly upon the use of wetting agent within the mass by invoking the doctrine of equivalents. *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U. S. 126; *Taylor-Reed Corp. v. Mennen Food Products*, 7 Cir., 324 F. 2d 108; *Bauer v. Yetter Mfg. Co.*, S. D. Ill., 205 F. Supp. 904, aff'd 315 F. 2d 377.

I find and conclude that the accused product does not infringe the claims of the patent in suit. Thus, there is no necessity to consider the issue of validity. The court's findings of fact are included in the foregoing memorandum.

Conclusions of Law.

1. The court has jurisdiction of the parties and subject matter in the cause of action.

2. Words used in the claims of a patent must be given their ordinary and accustomed meaning unless it appears from the patent application and the specifications that the inventor attached some different meaning thereto. Cf., *Apex Electrical Mfg. Co. v. Altorfer Bros. Co.*, 7 Cir., 238 F. 2d 867, 873.

3. To prove a patent infringed, the complaining party must prove not only that the accused product accomplishes the same result, but, also, that the accused product achieves that result by substantial piracy of the invention claimed or by an equivalent means. *Zyaset v. Popeil Brothers, Inc.*, 7 Cir., 276 F. 2d 354, 357; *Hunt v. Armour*, 7 Cir., 185 F. 2d 722, 728. The function of an invention is not patentable. Variations of form to achieve the same result may be disregarded upon the question of infringement, but an accused product does not infringe a patent unless the substance of the invention claimed is employed by the alleged infringer. *Westinghouse v. Boyden Power Brake Co.*, 170 U. S. 537, 569.

4. Before infringement can be found, the evidence must reveal that the placement of the elements of the accused material correspond to the claim of "a layer of a wetting agent on the exterior of the mass adapted to carry water into the interior of the mass," or that the elements of the accused material are so arranged as to require application of the doctrine of equivalence. *Independent Pneumatic Tool Co. v. Chicago Pneumatic Tool Co.*, 7 Cir., 194 F. 2d 945, 947.

5. The doctrine of equivalence cannot be invoked by a patentee to recapture a monopoly which he disclaimed

in order to obtain the grant of his patent. *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U. S. 126, 136-7. *Taylor-Reed Corp. v. Mennen Food Products*, 7 Cir., 324 F. 2d 108. *Bauer v. Yetter Mfg. Co.*, D. C. Ill., 205 F. Supp. 904, 906, 909, aff'd 315 F. 2d 377.

6. Defendants are entitled to judgment dismissing plaintiff's suit and to their costs.

Judgment is ordered in accordance with the findings and conclusions hereinabove expressed.

Entered this 18th day of March, 1964.

FREDERICK O. MERCER,
United States District Judge.

DECISION OF THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

(December 23, 1964.)

Before HASTINGS, *Chief Judge*, and DUFFY and MAJOR, *Circuit Judges.*

MAJOR, *Circuit Judge.* Plaintiff is the owner by assignment of United States Letters Patent No. 2,753,277, issued July 3, 1956, to Vernon L. Smithers, entitled "Absorbent Material for Floral Arrangements." Plaintiff is engaged in the manufacture and sale of the patent product, namely, a hydrophilic floral foam, which it markets under the trade name "Oasis."

Defendants, wholesale florists who sell a product manufactured by American Metaseal of Massachusetts, Inc., which is marketed under the trade names "Aqua-foam" and "Quickee," are charged with infringement.

The District Court (Honorable Frederick O. Mercer presiding) on March 18, 1964, entered judgment from

which this appeal comes, dismissing the action on the ground of non-infringement.

Plaintiff's principal grounds for reversal are that the District Court erred in its interpretation of the claims of the patent in suit and in its application of the law of equivalence and "file wrapper estoppel."

The judgment followed an opinion rendered by Judge Mercer which embodies his findings of fact and conclusions of law. *The V. L. Smithers Mfg. Co. v. O'Brien et al.*, 227 F. Supp. 472. In his opinion he discusses in detail the evidentiary facts developed at the hearing which form the basis for his findings and conclusions of law. We are convinced after a careful examination of his opinion that his findings are adequately supported and that his conclusions of law are correct. We thus are in agreement both with the reasoning employed and the result reached. Such being the situation, we think no useful purpose could be served in retreading the ground which he has so well covered. Therefore, we adopt his opinion as that of this Court.

The judgment is AFFIRMED.

ORDER DENYING REHEARING.

(Entered February 16, 1965.)

IT IS ORDERED by the Court that the petition for a rehearing of this cause be, and the same is hereby, DENIED.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 137

THE V. L. SMITHERS MANUFACTURING COMPANY,
Petitioner,

vs.

WILLIAM P. O'BRIEN AND WILLIAM J. O'MALLEY,
D.B.A. ILLINOIS WHOLESALE FLORIST,
Respondents.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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THE GUNTHORP-WARREN PRINTING COMPANY, CHICAGO

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Respondents.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

There are no special or important reasons why certiorari should be granted in the present case. The Court of Appeals, from whose decision review is sought, correctly applied the well-established rule of law that a patentee having limited his claims in the Patent Office cannot take the position in court that his claims have a different and broader meaning. In arriving at this decision, the Court of Appeals relied on principles established by this Court in the case of *Exhibit Supply Co.* v. *Ace Patents Corp.*, 315 U. S. 126, 136-7 (1942) (A12).

The Question Here.

We cannot agree with the Petitioner as to Questions 1 and 2 (Petition p. 2). The canceled application claim lacked no element essential to the utility of the construction claimed. The patented claims include an element essential to confer patentability but not essential to utility. This element is stated in specific structure and not as means for performing a function so that the statute (35 USC 112) does not apply. The element is *not* included in the Defendant's structure either as such or in any equivalent form. Therefore, neither questions 1 nor 2 are properly before this court. On pages 8-9 hereof, we will state what we believe to be the only question in issue.

There is no reason for the Court to consider the third question. Where, as here, non-infringement is so clear there is no need to decide whether or not the patent is valid.

FACTS.

In its statement of the case, Petitioner has omitted some very important facts and has misstated others.

Difference in Manufacture.

The product which both the Petitioner and the Respondent sell is made from a mass or block of synthetic foam material consisting of thousands of cells, some open and some closed (36a-37a). The foam is formed in a large mass and then cut into smaller blocks (72a), the exterior surfaces of each block consisting of open and closed cells depending upon whether the cells were cut through when the block was made (51a). These blocks are then treated in an entirely different manner by each of the parties.

The foam is not only old, but it had been used before for

decorative and artistic flower arrangements (17a). It is hydrophobic as stated by the Petitioner. In order to make it hydrophilic, i.e., so that it will absorb water, the Smithers patent discloses spraying or dusting a layer of a wetting agent* on the exterior surfaces of the block for the following reasons:

> "The fact that the wetting agent is concentrated on the surface of the block and is carried into the block by the water, causes the concentration of the wetting agent to progressively diminish as the water is absorbed by the block. This action is very desirable because the concentrated wetting agent is not beneficial to the flowers, but as it is only in a very dilute solution in the interior of the block, any deleterious effects of the wetting agent are nullified.
>
> "An important advantage in coating the exterior of the foam with the wetting agent is that the dried layer of wetting agent will act as a binder over the exposed surface of the block, and this will prevent the objectionable dusting off of fine particles of the material in handling." (109a, Col. 4, lines 4-17.)

Every claim in the patent is limited to wetting agent located on the exterior of the mass of foam (110a).

Defendants' structure is a block of the same foam approximately 9" long, $4\frac{3}{4}$" wide and $3\frac{1}{8}$" deep. One face of the block, which is 9" x $4\frac{3}{8}$", has 272 holes, the diameter of each of which is not much bigger than the head of a common pin (74a), punched into it by needles. The District Court described the structure as follows:

> "The accused product is made from a phenolic resin foam of the same character as that used in Oasis. After the foam has set and dried, it is cut in blocks or masses of the desired size. These blocks or masses are placed upon a machine which injects one surface of the block

*Wetting agents are old, well known chemical substances which cause materials that repel water to accept it. A household detergent is one example of such a material (81a-85a).

with a large number of needles which penetrate the mass to within a short distance from the opposite surface thereof. After the points of the needles have penetrated within the interior of the mass, a liquid wetting agent is fed through the needles into the mass. The machine used is so designed that the feed of wetting agent through the needles ceases before the needles are withdrawn from the block of foam. The resulting product is a mass of foam having a large number of holes or openings upon one exterior face thereof with the wetting agent disposed therein." (A4-5.)

Obviously all of the wetting agent is inside the foam block. None is on the outside to draw water into the foam so that the concentration of the wetting agent progressively diminishes and none acts as a binder over the surface of the block to prevent the objectionable dusting off of fine particles of the material in handling, the reasons urged for granting the claims of the patent.

What Lower Courts Decided.

Contrary to what the Petitioner says the District Court found non-infringement because (1) the Respondents' structure does not meet the terms of the claims, i.e., it does not have a layer of wetting agent on the exterior of the mass of foam (A9-10) and (2) Petitioner was estopped to rely on the doctrine of equivalents to construe claims specifying wetting agent on the exterior of the foam as covering a construction where the wetting agent is in the interior of the foam (A10). The Court concluded as follows (A11):

"4. Before infringement can be found, the evidence must reveal that the placement of the elements of the accused material correspond to the claim of 'a layer of a wetting agent on the exterior of the mass adapted to carry water into the interior of the mass,' or that

the elements of the accused material are so arranged as to require application of the doctrine of equivalence. *Independent Pneumatic Tool Co.* v. *Chicago Pneumatic Tool Co.*, 7 Cir., 194 F. 2d 945, 947.

5. The doctrine of equivalence cannot be invoked by a patentee to recapture a monopoly which he disclaimed in order to obtain the grant of his patent. *Exhibit Supply Co.* v. *Ace Patents Corp.*, 315 U. S. 126, 136-7. *Taylor-Reed Corp.* v. *Mennen Food Products*, 7 Cir., 324 F. 2d 108. *Bauer* v. *Yetter Mfg. Co.*, D. C. Ill., 205 F. Supp. 904, 906, 909, aff'd 315 F. 2d 377."

The Court of Appeals agreed (A13).

History of Patent Application.

The original application, of which the patent in suit is a continuation-in-part, disclosed three ways of applying the wetting agent to the foam, namely (128a-9a):

1. ". . . spraying a concentrated solution . . . upon the surface of a block of foam."

2. A wetting agent in powdered form ". . . may be simply dusted upon the surface of the foam. . . ."

3. Immersing a block of foam in ". . . water containing a wetting agent."

There was no mention of any inoperative wetting agent being in the foam. The examples given were where the foam was either immersed in water to which the wetting agent had been added, or the foam was "treated" with a wetting agent and then immersed.

There were eight claims (130a). Claim 1 read as follows:

"As an article of manufacture, a synthetic organic foam and a wetting agent carried in the cells thereof."

Claim 2 read:

> "As an article of manufacture, a mass of foam of resinous plastic having interconnected cells and a wetting agent *carried in the cells opening on the surface of said mass.*" (Emphasis ours.)

Claims 3 to 7 all referred to the article of claim 2 or the method of making such article. Claim 8 called for the method of making the article by immersing the foam in water to which the wetting agent had been added.

The Patent Office rejected all of these claims as unpatentable over the prior art which disclosed the foam and wetting agents, because it was obvious to use a wetting agent to make a foam "wettable" and because the claims were broad enough to include materials which could not operate for the intended purpose (131a-2a).

In the amendment responding to this rejection the inventor added the following statement to the specification (133a):

> "When the wetting agent is applied to the surface of the foam it has been found that it binds the foam together and reduces the tendency of the surface of the foam to disintegrate as a fine dust on handling. A further advantage in applying the wetting agent to the exterior of the mass of foam is that when the foam is immersed in water the water, as it migrates to the interior of the foam, will carry the wetting agent with it in constantly decreasing concentration. Hence, the wetting agent in the interior of the foam will be diluted to such an extent as not to affect adversely flowers, the stems of which are embedded in the foam."

All of the original claims were then cancelled in this amendment and new claims were added, each of which called for applying a wetting agent to the exterior of the foam material (134a-5a). In contending that these new claims were allowable, the applicant argued (136a):

"When the wetting agent is applied *to the exterior* of the finished foam, the inherent resistance of the foam to penetration by water is overcome. In addition, the wetting agent acts as a binder preventing disintegration of the surface of the foam by attrition, and as the wetting agent is carried by the water *to the interior* of the foam, the wetting agent is diluted so that it does not cause premature wilting of the flowers.

The claims as redrafted call for the application of the wetting agent *to the exterior* of the foamed mass where it will be carried by water *into the interior* of the mass. These claims distinguish from the art of record." (Emphasis ours.)

Attached to this amendment was an affidavit of the inventor which further argued as follows (139a):

"A further advantage in coating *the exterior* of the foam, whether in block or shredded form, is to prevent the objectionable dusting off of the fine particles of the material in handling. The *dried outer coating* of the wetting agent *binds the surface* of the material together and prevents the disintegration of the surface of the foam.

A further advantage in applying the wetting agent *to the exterior* of the mass of foam is that when the foam is immersed in water, the water, as it migrates *to the interior* of the foam, will carry the wetting agent with it in constantly decreasing concentration. Hence, the wetting agent *in the interior* of the foam will be diluted to such an extent as not to affect adversely flowers, the stems of which are embedded in the foam." (Emphasis ours.)

The applicant also stated in this amendment (136a):

"It is true that various forms of wetting agents are used in the manufacture of foams made of synthetic resinous materials, as described in the prior art patents cited by the Examiner (Curs, Nelson, Brinkema and Wilson). Applicant himself uses a wetting agent ('Tween') in the manufacture of his phenol-formaldehyde foam which he sells to the floral trade, after treating it, under the trade name 'Oasis.'

> The purpose of adding a wetting agent to the phenol resin (or urea-formaldehyde) before foaming is to reduce the excessive brittleness of the foam and to impart to it a limited degree of softness and resilience. For some reason that is not clear, the wetting agent loses all of its properties as a wetting agent during the generation of the foam."

This was the first time that an inoperative wetting agent in the foam was ever mentioned. The wetting agent of the application itself (129a) was an active wetting agent. The original application was later abandoned and the patent in suit issued on a continuation-in-part application (107a-111a). This application described the inclusion of a wetting agent in the foam ingredients during manufacture to decrease its brittleness (108a) and stated that this wetting agent loses its wetting powers during such manufacture. This was obviously not the wetting agent of the original aplication (129a) and claims 1 and 8 thereof (130a).

The block of foam defined by the claims of the original application must be construed in the light of the disclosure and therefore it could only include an active wetting agent. This wetting agent served to wet the foam, i.e., draw water into it. It could not be inactive or inoperative as Petitioner would have this Court believe. Cancelled claim 1 therefore lacked no element essential to the utility of the claimed structure—but it lacked an element *essential* to patentability, i.e., the specific location of the wetting agent. The only reason the Smithers patent was granted was because the inventor convinced the Patent Office that it was new to locate the old and well-known wetting agent in a specific place, i.e., on the exterior of this foam, to get the advantages already discussed.

The real question presented therefore is whether a claim, which specifies a foamed mass having a layer of a wetting agent on the exterior surfaces thereof which will carry

water into the mass with a constantly decreasing concentration of the wetting agent and which will act to protect the exterior of the foam, is infringed by a block of foam which has wetting agent in the interior thereof and none on any exterior surface. There is no question of the doctrine of equivalents since in Respondent's product the wetting agent being within the foam cannot decrease in concentration as the water enters and cannot protect the exterior. Respondent's wetting agent location is not equivalent therefore in any way to the location claimed in the Smither's patent. To so extend the claim language would make it cover the structure of cancelled application claim 1 which did not define the location of the wetting agent in the foam. The real question was answered by the District Court and the Court of Appeals in the negative. They also correctly held the doctrine of equivalents was not available. Non-infringement was so clear that neither Court found it necessary to go into the matter of the validity of the patent.

There Is No Conflict With Other Circuits on the Doctrine of Equivalents.

In *I. T. S. Rubber Company* v. *Essex Rubber Company*, 272 U. S. 429 (1926) this Court said at page 443:

> "It is well settled that where an applicant for a patent to cover a new combination is compelled by the rejection of his application by the Patent Office to narrow his claim by the introduction of a new element, he cannot after the issue of the patent broaden his claim by dropping the element which he was compelled to include in order to secure his patent. *Shepard* v. *Carrigan*, 116 U. S. 593, 597. If dissatisfied with the rejection he should pursue his remedy by appeal; and where, in order to get his patent, he accepts one with a narrower claim, he is bound by it. *Shepard* v. *Carrigan, supra*, 597; *Hubbell* v. *United States*, 179 U. S. 77, 83. Whether the examiner was right or wrong in rejecting the orig-

inal claim, the court is not to inquire. *Hubbell* v. *United States, supra,* 83. The applicant having limited his claim by amendment and accepted a patent, brings himself within the rules that if the claim to a combination be restricted to specified elements, all must be regarded as material, and that limitations imposed by the inventor, especially such as were introduced into an application after it had been persistently rejected, must be strictly construed against the inventor and looked upon as disclaimers. *Sargent* v. *Hall Safe & Lock Co.,* 114 U. S. 63, 86; *Shepard* v. *Carrigan, supra,* 598; *Hubbell* v. *United States, supra,* 85. The patentee is thereafter estopped to claim the benefit of his rejected claim or such a construction of his amended claim as would be equivalent thereto. *Morgan Envelope Co.* v. *Albany Paper Co.,* 152 U. S. 425, 429. So where an applicant whose claim is rejected on reference to a prior patent, without objection or appeal, voluntarily restricts himself by an amendment of his claim to a specific structure, having thus narrowed his claim in order to obtain a patent, he 'may not by construction, or by resort to the doctrine of equivalents, give to the claim the larger scope which it might have had without the amendments which amount to a disclaimer.' *Weber Elec. Co.* v. *Freeman Elec. Co.,* 256 U. S. 668, 677."

Applying this rule to the present case we find that the original claim which the patentee filed called for a block of foam with a wetting agent in the cells thereof, i.e., the cells on the exterior surface as well as in the interior of the block. For reasons referred to on pages 5 to 8 hereof, the patentee limited his claims to a block having a wetting agent on the exterior surfaces only. Whether or not the prior art required him so to do is unimportant. The fact is that the Examiner rejected claims which did not specify the location of the wetting agent on the exterior surfaces of the block and accepted claims where the location was specified. As this Court stated, "Whether the examiner was right or wrong in rejecting the original claim, the court is not to inquire."

It should be noted, however, that the Examiner was right. During the prosecution of the original application the Examiner rejected the claims because "It would appear obvious to use a wetting agent to make a foam 'wettable'" (132a). In responding to this rejection the applicant stated "We do not agree that it is obvious or without invention to coat the exterior of a block of foam made of these synthetic resins with a wetting agent" (137a). In other words, the inventor argued that it was not obvious to put the wetting agent on the outside of the block. He did not argue that it was invention for the wetting agent to be "carried in the cells" of the foam.

The facts here are analogous to those in *Exhibit Supply Co.* v. *Ace Patents Corp.*, 315 U. S. 126 (1942), which decision is controlling here. In that case the Supreme Court said at page 136:

> "Whatever may be the appropriate scope and application of the doctrine of equivalents, where a claim is allowed without a restrictive amendment, it has long been settled that recourse may not be had to that doctrine to recapture claims which the patentee has surrendered by amendment.
>
> "Assuming that the patentee would have been entitled to equivalents embracing the accused devices had he originally claimed *a 'conductor means embedded in the table,'* a very different issue is presented when the applicant in order to meet objections in the Patent Office, based on references to the prior art, adopted the phrase as a substitute for the broader one *'carried by the table.'* Had Claim 7 been allowed in its original form it would have read upon all the accused devices since in all the conductor means complementary to the coil spring are 'carried by the table.' By striking that phrase from the claim and substituting for it 'embedded in the table' the applicant restricted his claim to those combinations in which the conductor means, though carried on the table, is also embedded in it. By the amendment he recognized and emphasized

the difference between the two phrases and proclaimed his abandonment of all that is embraced in that difference. *Hubbell* v. *United States,* 179 U. S. 77, 83, 45 L. ed. 95, 99, 21 S. Ct. 24; *Weber Electric Co.* v. *E. H. Freeman Electric Co.,* 256 U. S. 668, 677, 678, 65 L. ed. 1162, 1167, 1168, 41 S. Ct. 600; *I. T. S. Rubber Co.* v. *Essex Rubber Co.,* 272 U. S. 429, 440, 444, 71 L. ed. 335, 341, 343, 47 S. Ct. 136; *Smith* v. *Magic City Kennel Club,* 282 U. S. 784, 789, 75 L. ed. 707, 712, 51 S. Ct. 291; *Schriber-Schroth Co.* v. *Cleveland Trust Co.,* 311 U. S. 211, 85 L. ed. 132, 61 S. Ct. 235, cf. in case of disclaimer *Altoona Publix Theatres* v. *American Tri-Ergon Corp.,* 294 U. S. 477, 492, 493, 79 L. ed. 1005, 1015, 1016, 55 S. Ct. 455. The difference which he thus disclaimed must be regarded as material, and since the amendment operates as a disclaimer of that difference *it must be strictly construed against him. Smith* v. *Magic City Kennel Club, supra* (282 U. S. 790, 75 L. ed. 712, 51 S. Ct. 291); *Shepard* v. *Carrigan,* 116 U. S. 593, 598, 29 L. ed. 723, 724, 6 S. Ct. 493; *Goodyear Dental Vulcanite Co.* v. *Davis,* 102 U. S. 222, 228, 26 L. ed. 149, 151. As the question is one of construction of the claim it is immaterial whether the examiner was right or wrong in rejecting the claim as filed. *Hubbell* v. *United States, supra* (179 U. S. 83, 45 L. ed. 99, 21 S. Ct. 24); *I. T. S. Rubber Co.* v. *Essex Rubber Co., supra* (272 U. S. 443, 71 L. ed. 342, 47 S. Ct. 136). It follows that what the patentee, by a strict construction of the claim, has disclaimed—conductors which are carried by the table but not embedded in it—cannot now be regained by recourse to the doctrine of equivalents, which at most operates, by liberal construction, to secure to the inventor the full benefits, not disclaimed, of the claims allowed." (Emphasis added.)

Claims for a block of foam with a wetting agent carried in the cells of the foam and claims to a block with the wetting agent on the exterior thereof are just as different as the claims in the above case and the resulting disclaimer just as clear.

Two of the cases on which the Petitioner relies as being contrary to the decision of the District Court and Court of Appeals in the present case have no pertinency whatsoever. In *Musher Foundation, Inc.* v. *Alba Trading Co., Inc.*, 150 F. 2d 885 (C. A. 2, 1945) the claims had been allowed but were later cancelled for reasons not of record. The Court said (p. 888) that under such circumstances the remaining claim was "entitled to the same range of equivalents as though the three claims had not been cancelled". In *New York Scaffolding Co.* v. *Whitney*, 224 Fed. 452 (C. A. 8, 1915), the claims had not been cancelled but had been persisted in and eventually allowed. The part of the decision quoted by Petitioner is pure dictum. In the other cases cited the patentee had not limited his claims to a specific structure as was done by the patentee in the present case. There is, therefore, no conflict with any other decision.

No Conflict With Statute.

The argument of Petitioner with respect to conflict with the statute is not understood. The statute reads as follows:

> "An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." (35 U. S. C. 112, par. 3.)

Not a single one of the claims in the patent in suit includes the word "means". They recite specific structure. How there can be any conflict with the statute is beyond comprehension.

VALIDITY.

There can be no question but that this Court in *Sinclair & Carroll Co.* v. *Interchemical Corp.*, 325 U. S. 327 (1945), said that it would usually be the better practice to decide validity after a trial of a patent infringement action. This has never, however, been interpreted as being an absolute requirement where, as in the present case, lack of infringement is so clear. For example, in *Coe Mfg. Co.* v. *Jeddeloh Bros.*, 306 F. 2d 455 (1962), the Court of Appeals for the Ninth Circuit said (p. 456):

> "the question of infringement of the claims in issue is a close one, at least with regard to Claim 17. At all events, non-infringement is not readily apparent or perfectly clear; hence, the question of the validity of the claims should have been determined by the trial court."

There has been no holding by this Court or by any Court of Appeals that where the fact of non-infringement is clear, a holding as to the validity of the patent is necessary.

CONCLUSION.

The petition should be denied.

Respectfully submitted,

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In the Supreme Court of the United States

OCTOBER TERM, 1964.

No. [redacted] 137

THE V. L. SMITHERS MANUFACTURING COMPANY,

Petitioner,

vs.

WILLIAM P. O'BRIEN and WILLIAM J. O'MALLEY, d.b.a. ILLINOIS WHOLESALE FLORIST,

Respondents.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

REPLY BRIEF OF PETITIONER.

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ON PETITION FOR WRIT OF CERTIORARI
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REPLY BRIEF OF PETITIONER.

The Accused Foam Has Exterior Layers Recessed Into the Blocks.

Respondents' description of the manufacture of the accused material (R. B. 2-4)* stops with the injection of the *solution* of wetting agent into the perforations in the block. There is no dispute in the evidence that thereafter the wetting agent solution dries by evaporation of the water, forming dried layers of wetting agent on the surfaces of the holes, which layers are positioned to contact water when the mass of foam is immersed in water, and which then act to draw the water into the interior of the mass of foam (A 7).

* Pages of Respondents' brief are referred to as "R.B." ; pages of Petitioner's Appendix filed in the Court below are referred to as (a); pages of the Appendix annexed to the Petition are referred to as (A).

While the solution of wetting agent injected into the holes in Respondents' material initially soaks into the foam, as it does when sprayed onto the blocks or chunks shown in the patent, the drying concentrates the wetting agent in layers on the surfaces of the holes, just as it does on the surfaces of the block or the irregular surfaces shown in the patent (34a, 48a, 99a; 109a, ll. 67-69).

Thus in the Respondents' block, as in the patented block, the wetting agent concentrates in layers on surfaces of the foam which are positioned to contact water when the blocks are immersed in water.

When either of the blocks are completely saturated with water the concentration of the dissolved wetting agent diminishes throughout the mass of foam (38a). Both parties use only the minimum amount of wetting agent necessary to obtain complete saturation (93a). Thus, both parties have insufficient wetting agent in the saturated blocks to injure the flowers; but before saturation both parties have dried layers of wetting agent on surfaces accessible to the water, the layers being sufficiently concentrated to cause the water to penetrate and be carried into the foam.

As the District Court found, in Respondents' blocks the water enters the perforations and contacts the dried wetting agent "after which water is quickly drawn into the interior of the mass of foam" (A 7).

The only difference between the foams of the Petitioner and the Respondents is that Respondents have relocated the dried layers of wetting agent on the surfaces of holes recessed into the block for the purposes of appropriating the Petitioner's invention and avoiding liability by the pretense that these surfaces of the holes are not part of the "exterior" of the foam because they are recessed into the "inside" of the block.

Protection of Surfaces Subjected to Handling Is Not Claimed.

The patent claims are limited to layers of wetting agent of such concentration and location as to draw water into the interior of the foam, and the wetting agent in the Respondents' product is so located and concentrated. None of the claims are directed to layers of wetting agent of such a nature and location as to act as a binder on portions of the foam subjected to handling (R. B. 3, 4, 6, 7, 9), although this function is mentioned in the specification of the patent. It was also mentioned in some of the solicitor's arguments, but no claims were granted on this feature. Therefore, none of the claims which were granted are avoided by locating the wetting agent on surfaces not subjected to handling, because infringement is measured by the claims, not the specification (*Smith v. Snow*, 294 U. S. 1, 11).

Respondents' Arguments Shift from the Decisions Below to a Different Cancelled Claim.

The District Court and the Court of Appeals found estoppel based on the cancellation in the abandoned parent application of claim 1, limited to a foam with "wetting agent carried in the cells thereof" (A 10).

There was no finding of estoppel based on cancelled claim 2 now relied on by Respondents (R. B. 6, 10). This was necessarily true because to the extent claim 2 might have covered a layer of wetting agent on an exterior surface of the foam accessible to water this feature was not abandoned, but was insisted upon and granted in the claims in suit.

The cancelled claim 1 described inoperative wetting agent carried in the cells of the foam. Respondents' asser-

tion (R. B. 8) that the first mention of inoperative wetting agent in the cells was in the amendment in the parent application (136a) is wrong. It is described in the prior art patents on which the Examiner rejected claim 1. These disclosed mixing wetting agent in the resin before it is foamed, thereby producing foam with wetting agent "in the cells thereof," which is admittedly inoperative to cause water to soak into the foam. As the District Court held in footnote 6 (A 6) this wetting agent "remains within the cells" of the foam but is not active to cause wetting. The original claim 1, calling for wetting agent "carried in the cells," was properly rejected and cancelled because this was old and does not work. But it is a travesty to hold, as the Courts below did, that cancellation of this claim to an old and inoperative thing is an abandonment of all equivalents of the granted claims covering the patentee's new discovery which does work and which achieves new results.

Since the cancelled claim described a thing which does not work, it is self-evident that a construction of the granted claims to cover the Respondents' foam, which does work, is not a recapture of the disclaimed subject-matter of the cancelled claim—the evil intended to be prevented by the file wrapper estoppel rule.

The Conflict With Other Circuits Is Clear.

Respondents' assertions (R. B. 9, 13) that there is no conflict with other Circuits is unsupported. There is no dispute in Respondents' brief of the direct conflict of the decision of the Courts below with the decisions of the Court of Appeals for the Sixth Circuit (*Southern Textile Machinery Co. v. United Hosiery Mills Corp.*, 33 F. 2d 862, 866; *Farrington v. Haywood*, 35 F. 2d 628, 630-631) and

the Court of Appeals for the Fifth Circuit (*Hunt Tool Co. v. Lawrence,* 242 F. 2d 347, 354). Likewise, there is no dispute of the conflict with the ruling of the Second Circuit (*Musher Foundation Inc. v. Alba Trading Co.,* 150 F. 2d 885, 888) except to point out that in that case the Court additionally found no estoppel on another ground.

In these two decisions in the Sixth Circuit the Court held the granted claims to be infringed by equivalents which were not equivalents of the cancelled claims. In the Fifth Circuit decision the Court held the granted claims were infringed by equivalent structures so long as those were not the same as, or equivalents of, the prior art on which the cancelled claims had been rejected.

The decision of the Courts below in the instant case, on the contrary, hold the patentee forfeited all right to protection against equivalent re-locations of the exterior layers of wetting agent because of the cancellation of a claim which did not include an exterior layer, and which read upon prior art foams completely inoperative to achieve the new result of the patent. The accused foam which is operative and which does achieve the results of the patent (A 5-A 6) is not the equivalent of the inoperative prior art foams or the cancelled claim which read upon these inoperative prior art foams.

The subject-matter of the granted claims was not abandoned; on the contrary, it was persisted in and allowed. The cancellation of original claim 2 which was unpatentable for other reasons did not abandon the granted subject-matter even though wetting agent on the exterior of the foam was included in that claim.

Thus, on Respondents' own argument (R. B. 13) the decisions of the Courts below are also in direct conflict with the decision in *New York Scaffolding v. Whitney,* 224 Fed. 452, C. A. 8.

Nor is the decision of the Courts below in any way supported by this Court's decisions in *I. T. S. Rubber Co. v. Essex Rubber Co.*, 272 U. S. 429 or *Exhibit Supply Co. v. Ace*, 315 U. S. 126 (R. B. 9-12). In the former, this Court held (272 U. S. at page 443):

> "The patentee is thereafter estopped to claim the benefit of his rejected claim or such a construction of his amended claim as would be equivalent thereto."

Construing the granted claims to cover the accused *operative* foam does not make them equivalent to the cancelled claim covering *inoperative* foams.

In the second of these cases, this Court held (315 U. S. at page 136) that subject-matter disclaimed "cannot now be regained." Petitioner is not seeking to regain the inoperative subject-matter of the cancelled claims.

The Conflict With the Statute Is Clear.

Respondent (R. B. 13) mis-interprets the Statute (35 U. S. C. 112) as being limited to claims which include the *word* "means." But this is not the language of the Statute. Instead, the Statute provides that an element in a combination claim may be expressed as "a means" for performing a particular function without reciting all structure necessary to the function. The noun "means" as used in the Statute connotes "that through which, or by the help of which, an end is attained" (*Webster's New International Dictionary*, Second Edition). Such a "means" can be described in any appropriate language and then further limited, as in the claims in suit, by the functional clause "adapted to carry water into the interior of the mass." This functional clause defines the "layer" on the "exterior of the mass" of foam as being so located as to be accessible

to the water and of sufficient concentration to carry water into the interior of the mass of foam.

The Statute says this claim "shall be construed to cover" the corresponding structure described in the specification and also "equivalents thereof." The decision of the Courts below is exactly contrary to this mandatory provision of the Statute, holding instead that the claims cover the layers on the flat surfaces of the block described in the specification but do not cover equivalent locations of those layers on surfaces recessed into the outline of the block.

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